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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,197

08/13/2008

Herve Moulin

1759.230

5666

23405

7590

04/12/2011

HESLIN ROTHENBERG FARLEY & MESITI PC
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EXAMINER

HAWTHORNE, OPHELIA ALTHEA

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

04/12/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,197	MOULIN, HERVE	
	Examiner	Art Unit	
	OPHELIA HAWTHORNE	3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 10 is/are pending in the application.
- 4a) Of the above claim(s) 4 - 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/22/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1 - 3 in the reply filed on 04/05/2011 is acknowledged. The traversal is on the ground(s) that in the initial Office Action requiring restriction between claims 1-3 drawn to a support fabric and claims 4-10 drawn to a method for producing a support fabric, no reason for insisting upon such restriction is presented. Applicant submits that a comparison of independent product claim 1 with independent method claim 4 will readily reveal that the claimed product and claimed method are intermittently related. Accordingly, the fields of search for the product and the method would appear to overlap. This is not found persuasive because according to the specification the support fabrics with pockets according to the invention can be used to make medical belts for lumbar support, post-surgery or abdominal belts, orthoses, splints, strapping etc. (see page 7 of specification). The species as recited in claims 4 - 10 are distinct because the claims to different species. Furthermore, these species are not obvious variants of each other as for example, Examiner takes the position that the method of making the support fabric is not limited to be used for belts but the method can be used to make orthoses such as wrist support, ankle support, knee support or full body support (i.e. scoliosis device) and is a separate and distinct species. The requirement is still deemed proper and is therefore made FINAL.

Claims 4 – 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or

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linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/05/2011.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed on 06/13/2008.

Information Disclosure Statement

The information disclosure statement filed 10/15/2010 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicant did not furnish an English Abstract Translation of the cited Foreign Patent Documents FRANCE 2787124, 2585237, GERMANY 4419410 AND 3049566. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Castell et al. (US 5,188,586). With respect to claims 1 – 3, Castell et al. discloses a back panel (5) of the brace (see figs. 1 – 6) constructed of two layers of woven elastic material, sewn together to form a pocket (30) having an opening (31) along the upper edge (12) of the back panel (5). A support pad or insert (35) is removably insertable within the pocket (30) and ([Col. 4], lines 58 – 62). Five stays 40 are secured to the back panel (5) and generally extend from the lower edge (14) to the upper edge (12) of the back panel in spaced relationship. The flexible stays (40) are constructed of a material having a greater rigidity than the woven elastic material of the back panel but flexible enough to flex with the back of wearer of the brace while in use. The preferred stays (40) are referred to as spiral stays, comprising coiled and flattened spring steel round wire. The stays (40) are secured to the back panel in stay receiving sleeves (41). The stays may be removably enclosed or nonremovably enclosed in the stay receiving sleeves 41. The stays (40) help to provide stiffness to the back panel (5) but allow the back panel to flex to conform the shape of the back of the wearer. The claim limitations “are joined by stitch bonding and, during production, are separated from one another in areas so that the layers” and”after production” are being treated as a product by process. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

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process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OPHELIA HAWTHORNE whose telephone number is (571)270-3860. The examiner can normally be reached on MONDAY - FRIDAY 8:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICIA BIANCO can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772

OPHELIA HAWTHORNE
Examiner
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